

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED
CENTRAL FAX CENTER

AUG 01 2005

In re Application of :
Joseph W. Coburn, Jr., et al :
Serial No. 10/664,024 :
Confirmation No.: 3503 :
Filed: 9/13/03 :
For: LAMINATED COLOR :
LIGHT FILTER :
Group Art Unit: 2872
Examiner: Chang, Audrey Y.
Attorney Docket No. 15262

Commissioner for Patents
P. O. box 1450
Alexandria, VA 22313-1450

Dear Sir:

RESPONSE TO OFFICE ACTION MAILED SEPTEMBER 10, 2004

Claim 7, rejected under 35 U.S.C. 112, second paragraph, has been canceled.

The rejection of claims 1-2 and 14 under 35 U.S.C. 102(b) as being anticipated by Sekimura et al is respectfully traversed.

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim" (Lindermann Maschinenfabrik GmbH v. American Hoise & Derrick Co., 730 F.2d 1452, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984) (citing Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 U.S.P.Q. 193 (Fed. Cir. 1983)) (emphasis added). The Sekimura et al reference fails to disclose each and every element of the

Serial No. 10/664,024

Page 2

claimed invention, as arranged in claims 1, 2 and 14.

Claims 1, 2 and 14 expressly recite a layer of substantially transparent dye-colored plastic laminated to a layer of substantially transparent glass and claim 2 further expressly recites a layer of substantially transparent adhesive laminating the layers of plastic and glass together. Sekimura et al does not teach lamination and in particular does not teach a layer of substantially transparent adhesive laminating a layer of substantially transparent dye-colored plastic to a layer of substantially transparent glass. No teaching of a substantially transparent adhesive is found in Sekimura et al. Lines 10-45 of column 7 of Sekimura et al provide no such teaching. In particular, at line 38 of column 7, the reference to silane is apparently incorrect. Silane is a gas, note the attached definition of silane as found in The Condensed Chemical Dictionary, Tenth Edition, published by Van Nostrand Reinhold Co., New York, NY, copy attached. Assuming for the sake of argument that the gas silane can function as a coupling agent, it would merely function as a primer which is a first coating applied to a surface in preparation of the application of a second coating; Sekimura et al expressly teaches at column 7, line 39, that silane is a primer -- not an adhesive. Accordingly, the elements recited in claims 1, 2 and 14 are not taught by Sekimura et

Serial No. 10/684,024

Page 3

al and under the controlling law cited above, are not anticipated by Sekimura et al and are respectfully submitted to be allowable.

Claims 3-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sekimura et al in view of the Japanese patent issued to Watanabe et al and the U.S. patent issued to Kobayashi, and this rejection is also respectfully traversed. Sekimura et al does not teach a layer of substantially transparent dye-colored plastic having a first thermal conductivity, a layer of substantially transparent base material having a second thermal conductivity greater than the first thermal conductivity and a layer of substantially transparent adhesive intermediate and laminating such layers together to provide heat transfer from the layer of substantially transparent dye-colored plastic to the layer of substantially transparent base material. As further noted above, Sekimura et al does not teach the use of a pressure sensitive adhesive and in particular does not teach a layer of substantially transparent adhesive providing such lamination. The Patent Office did not supply a copy of Watanabe et al but accepting the stated statement of the disclosure of this reference, it is clear that Watanabe et al does not supply the missing elements of Sekimura et al. Further, Kobayashi also does not supply the missing elements of Sekimura et al.

Serial No. 10/667,024

Page 4

Accordingly, a person of ordinary in this art would not find the elements claimed in claim 3 in these references and it is therefore submitted independent claim 3 is not obvious in view of this combination of references.

Still further, it is noted that none of these references contain a teaching, suggestion or motivation for combining their disclosures and that the combination of their disclosures, which applicants submit as being inadequate, would be in impermissible hindsight rejection. Accordingly, it is submitted that dependent claims 4-13, dependent directly or indirectly on independent claim 3 are allowable for the same reasons set forth with regard to independent claim 3.

With particular regard to dependent claim 9, all combination claims combine known elements and applicant's are the first to discover that the combination of a substantially transparent base material having a second thermal conductivity about four times the first thermal conductivity of the layer of substantially transparent dye-colored plastic provides the unexpected result of a laminated colored light filter providing heat transfer from the layer of substantially transparent dye-colored plastic to the layer of substantially transparent base material.

Referring again specifically to the statement that, "The silane adhesive layer is known in the art to be a

Serial No. 10/664,024

Page 5

pressure sensitive adhesive," is expressly, and respectfully, contradicted. There is no teaching in any of these references, particularly Sekimura et al, that silane is an adhesive or is a pressure sensitive adhesive. A determination of the 35 U.S.C. 103 question of obviousness must be based on a factual evidentiary foundation. Mere conclusory assertions alone do not constitute evidence which would support a conclusion of obviousness. Citing *Panduit Corp. v. Dennison Manufacturing Co.*, 1 U.S.P.Q. 2d 1593, 1595 (Fed. Cir. 1987). Without the citation of a reference teaching that silane is an adhesive, not a primer, and in particular is a pressure sensitive adhesive, the claim rejections based on Sekimura et al are improper since such is without factual evidentiary foundation as required by the controlling law noted above.

The rejection of claim 15 under 35 U.S.C. 103(a) as being unpatentable over the patent issued to Sekimura et al in view of the patent to Takushima et al is respectfully traversed. It is submitted that claim 15, dependent on claim 14, is allowable for the reasons set forth above with regard to claim 14 on which it depends as well as for its further limitation. In particular, it is submitted that Takushima et al does not supply the inadequacy of the Sekimura et al reference. It is accordingly submitted that claim 15 is not obvious and allowable.

Serial No. 10/66-024

Page 6

Enclosed is a separate listing of all claims showing that claim 7 has been canceled and that all other claims are original claims.

In view of the foregoing, allowance of this application is respectfully requested.

Respectfully submitted,



R. Gale Rhodes, Jr., Esq.
Of Counsel to
Moser, Patterson & Sheridan

RGR/jh
Attachments